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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 13

Application Number: 09/358,666

Filing Date: July 22, 1999

Appellant(s): LEIFER ET AL.

Edward A. Boeschenstein
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 23, 2001.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

The rejection of claim 16 under 35 U.S.C. 103(a) was an oversight by the Examiner in that claim 16 depends on claim 15 which was objected to in the previous office action. Therefore the rejection of claim 16 has been withdrawn by the Examiner.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 17-18 and 22-26 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

3,724,251 Wegner 4-1973

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Wenger.

Wenger discloses the same invention including a machine for slitting metal sheet, a first and second knives mounted to first and second mandrels (22), first and second roller assemblies which are urged together to compress strips between them (fig. 3 and 4), a first and second track (77, 69) a groove (fig. 11), a first pivotable arm (130) that is pivotable about an axes (col. 8, 62-68), clamp, spring bias (132), spring pad (94), and spacer (97).

Claims 17, 22-23, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wenger. Wenger discloses the invention substantially as claimed except for the length of the cylindrical surfaces. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide cylindrical surfaces of varying length, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wenger. Wenger discloses the invention substantially as claimed except for a second roller that is pivotable about an axis. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a second pivotable arm for the second roller assembly, since it has been held that mere duplication of the essential

working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

(11) Response to Argument

Appellant contends that Wegner does not show substantially cylindrical rollers which both contact the sheets and are urged together to compress the sheets. The Examiner disagrees. Figures 3 and 4 clearly show the sheets compressed between the rollers (30, 31). Additionally, the rollers would have to compress the strips of slit metal since the purpose of the rollers is to roll down any sharp protruding corners, burrs, projections, or deformities (col. 5, lines 36-39). Although Wegner teaches that the roll surface of each of the rollers (30, 31) has a shallow bevel or frusto-conical configuration this does not mean that the rollers cannot be substantially cylindrical. The term "substantially" does not refer to the exact structural feature, but rather consisting of or relating to a structural feature which allows room for slight deviation. Wegner teaches that the roll surface of each of the rollers has a shallow bevel (col. 5, lines 28-29), which by interpretation may be within the range of a "substantially" cylindrical roller. A shallow bevel can range anywhere from a minuscule dimension such as a nanometer to a larger dimension that would not constitute a "substantially" cylindrical roller. It is the Examiner's opinion that a shallow bevel with a minuscule dimension such as a nanometer would fall within the deviation allowed by the term "substantially" and therefore constitute a "substantially" cylindrical roller.

Appellant contends that Wegner does not suggest compressing strips of slit metal sheet between roller having cylindrical surfaces that are at least 2 inches longer

and that it would not have been obvious to one of ordinary skill in the art to modify the rollers such that the cylindrical surfaces are at least 2 inches because the Appellants invention and Wegner address two different problems. Appellant contends that Wegner does not recognize the problem solved by the Appellant's invention that is distortions that produce warpage and waviness in the strips. The Examiner disagrees. Figures 3 and 4 clearly show that the rollers compress the strips of slit metal. Additionally, the rollers would have to compress the strips of slit metal since the purpose of the rollers is to roll down any sharp protruding corners, burrs, projections, or deformities (col. 5, lines 36-39). Although, Wegner does teach rollers that are at least 2 inches long, it would have been a matter of design choice since modifying the cylindrical surfaces of the rollers such that they are at least 2 inches long is a mere change in the dimension which is well within the skill of any engineer knowledgeable in the art. The Examiner also disagrees with the Appellant's contention that Wegner does recognize the problem of warpage and waviness in the strips solved by the Appellants. In column 5, lines 38-39, Wegner teaches that the rollers roll any "deformities" in the sheet which in the Examiner's opinion would include the problems of warpage and waviness addressed by the Appellant's invention since the term "deformity" includes any physical distortions, physical disfiguration, or alteration in shape due to stress.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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knt

December 17, 2001

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